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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/076,424

02/19/2002

Jiro Moriyama

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12/08/2003

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EXAMINER

DO, AN H

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,424

Applicant(s)

MORIYAMA ET AL.

Examiner

An H. Do

Art Unit

2853

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-55 and 59-130 is/are pending in the application.
- 4a) Of the above claim(s) 23-55 and 59-102 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108-113 and 122-130 is/are allowed.
- 6) ☒ Claim(s) 103-107 and 114-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/511,230.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 8 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 103-130 in Paper No. 10 is acknowledged.
Applicant also cancelled the non-elected claims 23-55 and 59-102.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/511,230, filed on 04 August 1995.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 19 February 2002 and 12 December 2002 were filed and are being considered by the examiner.

Specification

4. The substitute specification filed 19 February 2002 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 103-107, 114-118, 120 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Allen (US 5,635,969).

Allen discloses an ink jet recording apparatus and method comprising: an ink ejection head (Figure 1, elements 12, 14, 16, 18) for ejecting ink; a processing liquid ejection head (Figure 1, element 20) for ejecting a processing liquid ; scanning means for performing a scanning operation (Column 5, lines 24-33); and control means for ejecting the processing liquid depending on a kind of the recording material in use (Column 5, lines 3-9). The control means prevents the ejection of the processing liquid when the recording medium is coated paper, OHP sheet or reception layer paper (column 1, lines 64-67 and column 2, lines 1-6). However, the control means permits the ejection of the processing liquid (A) when the recording medium is plain paper (column 4, lines 22-28). Allen further discloses the processing liquid comprising a cationic material and a polymeric component and the ink comprising an anionic dye and or pigment (column 2, lines 28-37).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5,635,969 in view of Okuda et al (US 5,476,043).

Allen discloses the claimed invention except for reciting that the processing liquid has a surface tension smaller than a surface tension of the ink.

Okuda et al teaches that the processing liquid has a surface tension smaller than a surface tension of the ink (column 6, lines 8-13).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to separate the ink from the processing liquid.

Allowable Subject Matter

5. Claims 108-113 and 122-130 are allowed.
6. The primary reason for the allowance of claims 108 and 122 is the inclusion of the limitation of wherein the control means prevents the ejection of the processing liquid from the processing liquid ejection head when a test printing mode operation is carried out. It is these limitations found in each of the claims, as they are claimed in the combination, that has not been found, taught or suggested by the prior art of record which makes these claims allowable over the prior art.

Contact Information


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 703-308-0525. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 703-308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



AD
November 30, 2003



Stephen D. Meier
Primary Examiner